

REMARKS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-4, 20, 29-31, 33, 36, 41, 45, 47, 70-72, 75, 77-78 and 82-85 were pending.

In the action dated 09/07/2006, the examiner rejected claims 1, 2, 29-31, 71, 75 and 82-74 as being rejected under 35 U.S.C. 102(b) as being anticipated by newly cited referenced Butterworth. For ease of comparison, the elements of Butterworth as cited by the examiner are listed below on the left, with applicants clarification and remarks on the right:

Examiner:

“Butterworth shows a particle entrapment pad 32 having an impervious bottom layer 96 and a high loft non-woven non-absorbent layer 23.”

Applicant:

The pad of Butterworth is not a particle entrapment pad. It teaches a method of making a high lift nonwoven fabric that, in its broadest teachings, can anticipate only the “preformed, high loft, non-absorbent nonwoven top layer” of the present Claim 1. However, the top layer of Butterworth teaches absorbency, not a non-absorbent upper layer. The same is true of the wood pulp inner layer. The present Claim 1 claims a chemically inert open pore matrix, which could not be used as a diaper in that it would not absorb urine or other liquids.

“A cling enhancing substance such as natural wood pulp fibers may be used for holding particles in place and when

Butterworth fails to teach an externally applied, chemically inert cling enhancing substance charged within said matrix or web of Claim 1.

deposited by air deposition the natural wood fibers cling to the synthetic wood fibers of the pad 32, the natural wood fibers being of an inherent nature as to be absorbent and reactive to other substances.

Further, the concept that the matrix of Butterworth could somehow capture particles during its formation does not teach or anticipate how such a device would be used to capture particles after the web is formed. Further, the Butterworth does not teach or anticipate a “high loft nonwoven top layer receives and entraps particles” as of Claim 1. Further, the statement that wood fibers are inherently absorbent teaches away from the present Claim 1 of a nonabsorbent open cell structure. Further still, applicant respectfully disagrees with the Examiner’s statement indicating any inherent properties assumed or imparted to the synthetic wood fibers of Butterworth. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. *In re Sun*, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished) But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed invention in the hand of one skilled in the art. . . . The examiner bears the burden of presenting at least a *prima facie* case of anticipation. *In re Sun*, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished)

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"The air deposition of the natural wood fibers on the pad 32 is considered to be preloading the pad 32 with reactive particles.

Again, Butterworth fails to teach an externally applied, chemically inert cling enhancing substance charged within said matrix or web of Claim 1. Applicant respectfully feels that the teachings of Butterworth at best teach away from the use of a preformed open cell web subsequently externally charged (AFTER the web is formed) with particle capturing substance

"It is considered that the pad of Butterworth is capable of or adapted to be used in a variety fo places and with various uses such as in workshops, offices, refrigerators and near pet food dishes or litter boxes."

Directed toward claim 29-31, Butterworth discloses only a diaper or similar fluid absorbing structure and not any means of capturing debris.

"Note that statements of intended use or field of use, "adapted to" clause s are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference"

Applicant does not see specifically any claim language in which utilizes an "adapted to" limitation; however, given the functional "adapted" or "functional" limitations are not to be disregarded or given "no weight" in view of the third paragraph of 35 U.S.C. 112. *In re Land*, 151 USPQ 621, 635–36 (C.C.P.A. 1966) Further still, applicant respectfully believes that any adaptation of a preformed, high loft, non-absorbent nonwoven open pore matrix or web attached to a bottom layer represents the patentable core of his innovation that is useful,

novel, and nonobvious in light of the Butterworth reference.

Overall, Butterworth does not describe an open cell fibrous web that is non absorbent, then **loaded** with a cling enhancer, i.e. “Charged within” that coats all of the web leaving the fiber with an attachable residue. In undertaking to determine whether one reference anticipates the claim(s) of an application under 35 U.S.C. § 102(a), § 102(b) or § 102(e), a primary tenet is that the reference must teach every element of the claim(s). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Each and every element of the claimed invention must be disclosed in a single prior art reference “arranged as in the claim.” Lindemann Maschinenefabrik GmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Applicant respectfully believes that the Butterworth reference, on a macro scale, may be misinterpreted to show what the present invention teaches on a micro scale, i.e. not within pore, but within large cavity formed between two layers. Further, Butterworth uses a thermoplastic synthetic wood pulp, not a preformed, high loft, non-absorbent nonwoven top layer forming a matrix or web. This is known by those skilled in the art to be quite different than Butterworth. Butterworth is heat fused thermoplastic synthetic wood pulp. Particularly, Applicant would like to reference the

Declaration under 37 C.F.R. 1.132 by Gary G. Orton, incorporated by reference herein and filed under separate cover, as evidence to be considered of the differences to those skilled in the art between the present invention and the web forming structure of Butterworth.

Further, in the action dated 09/07/2006, the examiner rejected:

- claims 3, 72, 78 and 85 under 35 U.S.C. 103(a) as being anticipated by newly cited referenced Butterworth in view of Kiebke;
- claims 4 and 33 under 35 U.S.C. 103(a) as being anticipated by newly cited referenced Butterworth in view of Goss;
- claims 20, 36, and 41 under 35 U.S.C. 103(a) as being anticipated by newly cited referenced Butterworth in view of Harris;
- claim 45 under 35 U.S.C. 103(a) as being anticipated by newly cited referenced Butterworth in view of Harris and further in view of Goss et al.;
- claims 47 under 35 U.S.C. 103(a) as being anticipated by newly cited referenced Butterworth in view of Harris and further in view of Kiebke.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j). Applicant respectfully reiterates the above arguments indicating the various differences of Butterworth as if rewritten, and would add further that nothing in Butterworth anticipates the loading of particles after the formation of the web, nor enables any functional capacity or feature that would allow such loading of any particles, including backing soda.

In regard to the several rejections of the claims under 35 U.S.C. § 103(a), based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself.

Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is

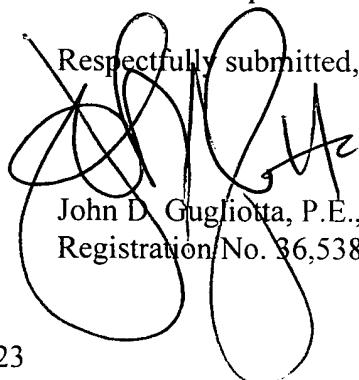
nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of taking a preformed, high loft, non-absorbent nonwoven chemically inert open pore matrix or web and externally applying a chemically inert cling enhancing substance charged within said matrix or web to form a particle entrapment pad. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

Finally, in the action dated 09/07/2006, the examiner rejected claims 1-4, 20, 29-31, 33 and 82-85 were rejected under 35 U.S.C. 112. Claims 1-2 have been amended to clarify the intended scope of the current teachings, but for further clarification the “cling enhancing substance” loaded into the web allows for reactive particles to be “stuck” thereto. This is a physical adherence type of attachment, not a chemical bond. For example (and to intended as a limitation) attaching dry solid particles of chlorine based cleanser particles will physically stick to, adhere to, embed to the tacky, dry ‘glue’, but not react to the glue or fibers. However, when a fluid such as water is introduced, the particles easily dissolve and are released (in the case of air, certain solid fragrances or deodorizers would react with malodor such that an external solution is formed). Or, as in claim 4, if a superabsorbent polymer is “stuck” to the fiber, is still ‘reacts’ to water, but does not chemically bond to the fiber or the cling enhancing substance.

While the applicant's goal and intent is to "charge" by spraying, brushing, bathing or otherwise inserting an inert cling enhancing substance, in to a preformed, nonabsorbent, open cell web category of synthetic fiber high lofts, Applicant believes that the 'cling enhancing substance' as defined in the application and read into claim 1 as amended above is not ambiguous, is broader than merely 'sticky', and is not anticipated by the wood pulp of Butterworth. Applicant does not desire to have the physical chemistry of adhesives to somehow unknowingly or unintendedly narrow this scope. Applicant wishes to, and is entitled to, claim any and all methods of charging actives into the inert web that does not result in chemical bonding to the fiber. It is believed that 'cling enhancing substance' does this, when read in light of the specification.

In summary, in regard to Butterworth, there are the differences described above, but in relation to the other claims there is no anticipation of: Cling agent charged into preformed web; Reactive particles attached to cling agent; Reactive particles loaded into web; and additional agents loaded into web.

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,

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